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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/808,468 03/14/01 DRESCH

T 840.066202

EXAMINER

MM91/0822

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NEW YORK NY 10017

NGUYEN, K

ART UNIT

PAPER NUMBER

2881

DATE MAILED:

08/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/808,468

Applicant(s)

Dresch et al.

Examiner

K. Nguyen

Group Art Unit

2881

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-10 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Objected Informalities

The disclosure is objected to because of the following informalities:

In The Claims

Claim 1, line 28, “;” should be changed to -- . --.

Claim 3, line 2, “configurations” should be changed to -- configuration --.

Appropriate correction is required.

Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the respective voltage levels and the duration of said voltage levels of said ion guide exit lens and said time of flight acceleration field" in lines 26-27. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the perpendicular direction" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the longitudinal ion beam axis" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "said ion guide" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the voltage level" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "said ion guide exit lens" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "said ion guide entrance lens" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the switching" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the respective voltage levels and the duration of said respective voltage levels of said ion guide exit lens and said time of flight acceleration field" in lines 9-11. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "said two dimensional ion guide" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the perpendicular direction" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the longitudinal ion beam axis" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Objected Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the two dimensional ion guide is in a

configuration that contains the ions in the perpendicular direction with respect to the longitudinal ion beam axis as recited in claims 3 and 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Double Patenting Rejection Under 35 U.S.C. 101

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of prior U.S. Patent No. 5,689,111. This is a double patenting rejection.

It is noted that claims 1-10, as understood by the meaning of 112, second paragraph; and the objected drawings above, are applied double patenting rejection under 35 U.S.C. 101.

The limitation "to determine the respective voltage levels and the duration of said respective voltage levels of said ion guide exit lens and the time of flight acceleration field" in claim 6 of Patent No. 5,689,111 is inherent in the limitation "using an accurate timing device synchronizing the switching of the respective voltage levels and the duration of said respective voltage levels of said ion guide exit lens and the time of flight acceleration fields" as recited in claim 6 of the Application No. 09/808,468.

This is a continuation of applicant's earlier Application No. 09/448,857. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Dresch et al. (6,020,586) disclose an ion storage time of flight mass spectrometer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner *Kiet T. Nguyen* whose telephone number is (703) 308-4855.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 09/808,468
Attorney's Docket No. 840.066.202

Art Unit: 2881
Paper No. 4

Papers related to Art Unit 2878 applications **only** may be submitted to Art Unit 2878 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "**DRAFT**". The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Art Unit 2878 Fax Center number is (703) 308-7723.

K.T.N/Primary
August 20, 2001



KIET T. NGUYEN
PRIMARY EXAMINER